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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,673	12/28/2001	Toshio Endo	1776-4070	9370

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EXAMINER

PEZZUTO, HELEN LEE

ART UNIT PAPER NUMBER

1713

DATE MAILED: 04/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,673

Applicant(s)

ENDO ET AL.

Examiner

Helen L. Pezzuto

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-- Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 20-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 16 and 17 is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-19 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that there would be no serious burden to examine the invention of Group I and II together because they are classified in the same class. This is not found persuasive because the copolymer in group II as claimed, can be made by other viable process as stated in the previous restriction requirement. Process include admixing a preformed copolymer of alkyl vinyl ether and maleic anhydride (produced by any method) with 0.5% by weight or less of a combination of a good solvent and a bad solvent. The inventions of group I and II are distinct as claimed.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 20-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

Claim Rejections - 35 USC § 102

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 7-11, 13-14, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Goertz et al. (US-558).

U.S. 4,952,558 to Goertz et al. discloses a method of preparing copolymer of anhydrides and alkyl vinyl ethers in the presence of a free radical initiator and an ester of not less than 5 carbons atoms as a solvent. Prior art exemplifies first adding an alkyl acetate and maleic anhydride to a reactor until maleic anhydride is dissolved, subsequently adding a solution of methyl vinyl ether, and subsequently copolymerize the mixture in the presence of an initiator at the boiling temperature of the ester solvent, resulting in a suspension product which meets the instant slurry product. The instant carboxylic acid ester as per claims 2-3 is disclosed and exemplified in the reference (col. 3, lines 29-49). Prior art discloses and exemplifies using 0.01-2% by weight of a free radical initiator which meets the terms of the recited claims 9,11 and 13. Suitable

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temperature range disclosed is from 30-150°C which encompasses the range expressed in claims 10 and 14.

Furthermore, prior art exemplifies removing the solvent and drying at 50°C which embraces the condition expressed in claim 18. Accordingly, the instant claims are anticipated by prior art disclosure.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-6, 12, 15 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goertz et al. (US-558) as discussed above and further in light of the following.

Although prior art preferred solvent is an ester of not less than 5 carbon atoms, the reference discussed using ethyl acetate as a solvent to yield a precipitated polymer product (col. 2, lines 30-38). It would have been obvious to one skilled in the art to use ethyl acetate as a solvent, although not preferred by prior art if product

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adhesion is not a concern for the intended purpose. It has been held that the disclosure of a composition in a reference may be anticipatory even though the reference indicates that the composition is not preferred or even that it is unsatisfactory for the intended purpose. In re Nehrenberg 126 USPQ 383. Regarding weight ratio of the respective monomers and that to solvent, as well as the temperature range of the polymerization, the examiner is of the position that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. Thus, rendering obvious the instant claims.

Allowable Subject Matter

7. Claims 16-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Prior art of record do not suggest adding a bad solvent after the completion of polymerization and adding a bad solvent while removing the organic solvent.

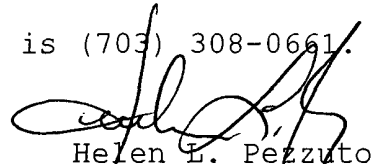
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L.

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Pezzuto whose telephone number is (703) 308-2393. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Helen L. Pezzuto
Primary Examiner
Art Unit 1713

hlp.
April 6, 2003